



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,792	03/27/2001	Ronald P. Sansone	F-183	9874

7590 10/08/2002
Ronald Reichman
Pitney Bowes Inc.
35 Waterview Drive
P.O. Box 3000
Shelton, CT 06484

EXAMINER

WOO, RICHARD SUKYOON

ART UNIT PAPER NUMBER

3629

DATE MAILED: 10/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/818,792

Applicant(s)

SANSONE ET AL.

Examiner

Richard Woo

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 March 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2-4 . 6) ☐ Other: .

DETAILED ACTION

Drawings

- 1) The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "24" and "28" have both been used to designate BCS in Fig. 2.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Double Patenting

- 2) The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

- 3) Claims 1, 2, 3, 4, 5, 6, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25, 26, 27, 28, 29, 30, 31, 32, 33, 34 and 35 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 20, 21, 22, 23, 24,

Art Unit: 3629

25, 26, 27, 28, 29, 30, 31, 32, 33 and 34, respectively, of copending Application No. 09/818,480.

Copending Application No. 09/818,480 claims a method that enables a recipient to inform a carrier to deliver a mail in a plurality of manners, comprising the steps of:

capturing the name and address of the recipient and the sender (capturing process including scanning or reading the name and physical address of the recipient and sender);

translating the name and address of the recipient into an e-mail address;

notifying the recipient of the availability of the mail;

depositing with the carrier mail containing the recipient's name and physical address and a sender's name and address;

notifying the carrier to deliver the mail to the recipient in the manner specified by the recipient;

wherein the recipient notifies the carrier to deliver the mail to a specified name and address; to return the mail to the sender; to open the mail; to extract the contents of the mail to the recipient and to mail by e-mail the information to the recipient;

informing the carrier to extract the contents of the mail to one or more e-mail address; and mailing by e-mail the information to the e-mail addresses;

informing the carrier to send by fax the contents to the recipient; and mailing by fax the contents to the recipient with at least one fax number;

wherein the recipient notifies the carrier to deliver the mail to the recipient at a different address;

wherein the recipient notifies the carrier to deliver the mail to the recipient by a slower or faster delivery than normal one;

charging the recipient for receiving notification of the availability of the mail, for the specific delivery manner;

informing the sender of the delivery of the mail;

wherein the recipient notifies the carrier to hold the mail;

wherein the recipient notifies the carrier to destroy the mail;

wherein the recipient notifies the carrier to recycle the mail;

wherein the recipient is notified via e-mail, telephone, fax or television of the availability of the mail;

wherein the carrier is notified via e-mail, fax, or telephone;

wherein the recipient notifies a data center as to notify the carrier;

wherein the mail contains a stamp, postal indicia, permit or symbology

wherein the graphic is captured and translated; and

wherein the graphic is stored.

This is a provisional obviousness-type double patenting rejection.

4) Applicant is advised that should claims 14 and 15 be found allowable, claim 16 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing

Art Unit: 3629

one claim to object to the other as being a substantial duplicate of the allowed claim.

See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

- 5) The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 6) Claims 1-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 1, lines 2 and 9, the recitation of "would like" renders the claim indefinite because it is not clear how the recipient want his/her mail to be delivered.

Several dependent claims suffer the identical indefiniteness as cited above.

In Claim 1, line 4, the recitation of "the sender" lacks antecedent basis.

Claim Rejections - 35 USC § 102

- 7) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

8) Claims 1-2, 4-6, 13, 17-18, 21, 25 and 28-30, as far as they are definite, are rejected under 35 U.S.C. 102(e) as being anticipated by Kanevsky et al. (US 6,285,777).

Kanevsky et al. discloses a method that enables a recipient to inform a carrier to deliver a mail in a plurality of manners, comprising the steps of:

depositing with the carrier mail (12) containing the recipient's name and physical address and a sender's name and address (see Figs.);

capturing the name and address of the recipient and the sender (see Figs.);

translating the name and address of the recipient into an e-mail address;

notifying the recipient of the availability of the mail;

notifying the carrier to deliver the mail to the recipient in the manner specified by the recipient;

wherein the recipient notifies the carrier to deliver the mail to a specified name and address; to open the mail (so as to scan the contents); to extract the contents of the mail to the recipient and to mail by e-mail the information to the recipient;

wherein the recipient notifies the carrier to deliver the mail to the recipient by a faster delivery (via e-mail is faster) than normal one;

informing the sender of the delivery of the mail;

wherein the recipient notifies the carrier to hold the mail;

wherein the carrier is notified via e-mail;

wherein the recipient notifies a data center as to notify the carrier; and

wherein the mail inherently contains a stamp.

Art Unit: 3629

9) Claims 1-3, 11-13, 17-18, 21, 25 and 28-30, as far as they are definite, are rejected under 35 U.S.C. 102(e) as being anticipated by Smith et al. (US 2002/0095306 A1 or US 2002/0042808 A1).

Smith et al. discloses a method that enables a recipient to inform a carrier to deliver a mail in a plurality of manners, comprising the steps of:

depositing with the carrier mail containing the recipient's name and physical address and a sender's name and address (see Figs.);

capturing the name and address of the recipient and the sender (see Figs.);

translating the name and address of the recipient into an e-mail address;

notifying the recipient of the availability of the mail (see generally the specifications);

notifying the carrier to deliver the mail to the recipient in the manner specified by the recipient;

wherein the recipient notifies the carrier to deliver the mail to a specified name and address; to return the mail to the sender;

wherein the recipient notifies the carrier to deliver the mail to the recipient at a different address;

wherein the recipient notifies the carrier to deliver the mail to the recipient by a slower or faster delivery than normal one (the recipient can choose different types of mail or parcel delivery);

informing the sender of the delivery of the mail;

wherein the recipient notifies the carrier to hold the mail;

wherein the carrier is notified via e-mail;
wherein the recipient notifies a data center as to notify the carrier; and
wherein the mail inherently contains a stamp, a postal indicia, permit and
symbolology.

10) Claims 1-2, 13, 17-18, 21-22, 24-25 and 28-30, as far as they are definite, are
rejected under 35 U.S.C. 102(e) as being anticipated by King et al. (US 2002/0002590
A1).

King et al. discloses a method that enables a recipient to inform a carrier to
deliver a mail in a plurality of manners, comprising the steps of:

depositing with the carrier mail containing the recipient's name and physical
address and a sender's name and address (see Figs.);

capturing the name and address of the recipient and the sender (see Figs.);

translating the name and address of the recipient into an e-mail address;

notifying the recipient of the availability of the mail;

notifying the carrier to deliver the mail to the recipient in the manner specified by
the recipient;

wherein the recipient notifies the carrier to deliver the mail to a specified name
and address;

wherein the recipient notifies the carrier to deliver the mail to the recipient by a
faster delivery (via e-mail is faster) than normal one;

informing the sender of the delivery of the mail;

wherein the recipient notifies the carrier to hold the mail;

wherein the recipient is notified via e-mail, telephone and video medium (e.g. PDA having a video display);

wherein the carrier is notified via e-mail;

wherein the recipient notifies a data center as to notify the carrier; and

wherein the mail inherently contains a stamp.

Claim Rejections - 35 USC § 103

11) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12) Claims 1-35, as far as they are definite, are rejected under 35 U.S.C. 103(a) as being unpatentable over Kara et al. (WO 99/21330) in view of EP1063602.

Kara et al. discloses a method that enables a recipient to inform a carrier to deliver a mail in a plurality of manners, comprising the steps of:

depositing with the carrier mail (130) containing the recipient's name and physical address and a sender's name and address;

notifying the recipient of the availability of the mail (see Figs.);

notifying the carrier to deliver the mail to the recipient in the manner specified by the recipient;

wherein the recipient notifies the carrier to deliver the mail to a specified name and address; to return the mail to the sender; to open the mail; to extract the contents of the mail to the recipient and to mail by e-mail the information to the recipient (see Figs.);

informing the carrier to extract the contents of the mail to one or more e-mail address; and mailing by e-mail the information to the e-mail addresses (see Fig. 1);

informing the carrier to send by fax (140) the contents to the recipient; and mailing by fax the contents to the recipient with at least one fax number;

wherein the recipient notifies the carrier to deliver the mail to the recipient at a different address;

wherein the recipient notifies the carrier to deliver the mail to the recipient by a slower (normal delivery) or faster (e-mail or fax) delivery;

charging the recipient for receiving notification of the availability of the mail, for the specific delivery manner;

informing the sender of the delivery of the mail;

wherein the recipient notifies the carrier to hold the mail; to destroy the mail; and to recycle the mail;

wherein the recipient is notified via e-mail, telephone, fax or television of the availability of the mail;

wherein the carrier is notified via e-mail, fax, or telephone;

wherein the recipient notifies a data center as to notify the carrier;

wherein the mail contains a stamp, postal indicia, permit or symbology

wherein the graphic is captured and translated; and

wherein the graphic is stored.

However, Kara et al. does not expressively disclose the method including:
capturing the name and address of the recipient and the sender; and
translating the name and address of the recipient into an e-mail address.

EP' 602 teaches, for a system and method for automatic notification of delivery of a mail, that the system and method includes:

database containing e-mail address of recipients in the mailing list;
automatically capturing the name and address of the recipient and the sender;
and
translating the name and address of the recipient into an e-mail address (by recognizing the recipient's e-mail address) (see Figs. 2 and 5).

Since the Kara et al. and EP' 602 are both from the same field of endeavor of automatically notifying the delivery of a mail, the purpose disclosed by EP' 602 would have been well recognized in the pertinent art of Kara et al..

Accordingly, it would have been obvious at the time the invention was made to a person having ordinary skill in the art, to incorporate the method of capturing and translating the name and address of the recipient into an e-mail address into the system of Kara et al., as taught by EP' 602, for the purpose of providing a system including automatic recognition of the recipient's e-mail address and sending notice of intended

delivery to the recipient so as to forward the service messages to the carrier or recipient in a more expeditious and effective manner.

Conclusion

13) The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

EP 0465011 is cited to show a method of encoding an e-mail address in a fax message and routing the fax message to a destination on a network.

US 6,273,267 is cited to show an article delivery system including the article each having sorting information and being arranged in proper delivery order through a plurality of arrangement paths.

WO 02/01434 is cited to show a method of addressing postal or electronic mail, using a number uniquely associated with address written on item, automatically reading the number and looking up a database to extract the full alphanumeric address.

WO 02/42979 is cited to show a package tracking device on the internet with e-mail notification, wherein a sender and a recipient of a package are provided e-mail messages including information from a sender or carrier web page and package location status.

"Sharp Extends Fax Line with Scan-to-e-mail Feature" (Purchasing, 11/16/2001, Vol. 129 Issue 9, p. 174, 1/3p, 1c) is cited to show one-touch scan-to-e-mail system

Art Unit: 3629

allowing users to scan multiple-page documents and having them sent to a programmed e-mail address for immediate delivery.

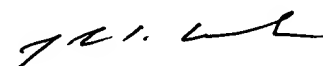
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Woo whose telephone number is 703-308-7830. The examiner can normally be reached on Monday-Friday from 8:30 AM -5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703-308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-308-3691 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0861.



Richard Woo
Patent Examiner
GAU 3629
September 30, 2002



JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600